

Application No. 09/553,573  
Amendment dated August 13, 2008  
Reply to Final Office Action of June 13, 2008

### **REMARKS**

Applicant cancelled claims 3 and 5, without prejudice or disclaimer of their subject matter, to further define Applicant's claimed invention.

In the Office Action, the Examiner indicated that claims "1, 4, 6-8, 1134 [sic], 36-38, 40-42, 101, 141-143, 169, 170" were allowed. (Office Action, page 2, line 16). It is Applicant's understanding that the Examiner meant to allow dependent claims 11-34. It is also Applicant's understanding that the Examiner meant to allow claim 171, which is dependent from allowed claim 170. Accordingly, Applicant submits that claims 1, 4, 6-8, 11-34, 36-38, 40-42, 101, 141-143, and 169-171 have been allowed by the Examiner.

The Examiner rejected claim 5 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Examiner stated that claim 5 "directly conflicts with amended claim 1 regarding the distances." (Office Action, page 2, line 13). Accordingly, Applicant cancelled dependent claims 3 and 5.

The Examiner rejected claims 102-130, 132-135, 137-140, 144-168, and 172-174 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,174,311 to Branch et al. ("Branch"); rejected claims 102-130, 132-135, 137-140, 144-168, and 172-174 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,607,424 to Tropiano ("Tropiano"); and rejected claims 102-130, 132-135, 137-140, 144-168, and 172-174 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over French Patent No. 2724312 to Albert ("Albert"). Applicant respectfully traverses the rejections on the grounds that none of Branch, Tropiano, or Albert discloses or suggests all of the recitations in independent claims 102 and 147.

Independent claims 102 and 147 each recite an implant having "a first distance as measured along the mid-longitudinal axis of said implant from an intersection of said leading end and the mid-longitudinal axis of said implant to an intersection of the mid-longitudinal axis of said implant and a plane perpendicular to and bisecting the length along the mid-longitudinal axis of said implant, said first distance being greater than a second distance as measured along the mid-longitudinal axis of said implant from an

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Intersection of said perpendicular plane and said exterior side wall to a junction of said leading end and said exterior side wall; and a third distance as measured along the mid-longitudinal axis of said implant from a junction of said leading end and said interior side wall to an intersection of said interior side wall and said perpendicular plane, said third distance being greater than said second distance, said first distance being greater than said third distance." Applicant respectfully disagrees with the Examiner's contention that the leading ends of the Implants of Branch, Tropiano, and Albert each meet "all claimed language regarding the first, second and third distances." (Office Action, page 4, lines 6-7; 19-20; page 5, lines 12-13).

FIG. 14 of Branch shows that the linear portion of leading end (117) of the implant passes through the intersection of the mid-longitudinal axis of the implant and leading end (117), and passes through the junction of interior side wall (128) and leading end (117). It is submitted that the first and the third distances in the implant of FIG. 14 of Branch are equal. FIG. 4 of Tropiano shows that the distance between leading end (16) of the implant and a plane perpendicular to and bisecting the length of the implant increases in a direction from the junction of leading end (16) with exterior side wall (14) to the junction of leading end (16) and interior side wall (12) of the implant. It is submitted that the first distance is less than the third distance in the implant of FIG. 4 of Tropiano.

Independent claims 102 and 147 recite an implant with a "leading end including a curved portion extending from the junction of said leading end and said exterior side wall to at least the intersection of said leading end and the mid-longitudinal axis of said implant." Applicant submits that FIG. 14 of Branch, FIG. 3 of Tropiano, and FIG. 2 of Albert each show an implant having a leading end (117), (16), and (16), respectively, that does not include "a curved portion extending from the junction of said leading end and said exterior side wall to at least the intersection of said leading end and the mid-longitudinal axis of said implant" as recited in independent claims 102 and 147.

Applicant respectfully disagrees with the Examiner's contention that the implants of Tropiano "are fully capable of being implanted opposite than that shown in figure 4." (Office Action, page 4, line 20). Tropiano teaches that trailing end (18) of the implant

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"has a threaded opening 39 to receive a positioning tool." (Tropiano, col. 3, lines 37-39). If the implant were to be implanted with trailing end (18) as the leading end, the positioning tool receiving opening would not be accessible to the surgeon, rendering it unusable for its intended purpose. Moreover, trailing end (18) of Tropiano does not include "a curved portion extending from the junction of said leading end and said exterior side wall to at least the intersection of said leading end and the mid-longitudinal axis of said implant" as recited in independent claims 102 and 147.

Additionally, independent claims 102 and 147 recite a spinal implant "being formed at least in part of a material other than bone." Branch teaches that "this invention relates to implants formed from donor bone." (See Branch, Abstract, line 1; col. 1, lines 7-8). In Branch, the "[r]eference to donor bone is understood, for the purposes of the present invention, to include cortical bone, cancellous bone, and any combination thereof, it being understood that cortical bone typically demonstrates greater structural integrity and is therefore a preferred material for fashioning load-bearing implants." (Branch, col. 21, lines 48-53). Branch does not teach or suggest an implant formed from a material other than bone as recited in independent claims 102 and 147.

Further, Applicant submits that the Examiner has failed to meet his burden of factually supporting a *prima facie* case of obviousness with respect to at least dependent claims 104, 107, 111, 114, 116, 118-119, 129, 130, 133-135, 137-140, 144, 148, 154-157, 159-166, and 172. The Examiner has not provided any evidence to support a showing that the recitations of these dependent claims are disclosed or suggested in each of Branch, Tropiano, and Albert.

Applicant respectfully submits that the Examiner's rejections of claims under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Branch, Tropiano, and Albert, respectively, have been overcome.

Applicant submits that independent claims 102 and 147 are patentable and that dependent claims 103-130, 132-135, 137-140, 144-146 and 148-168, and 172-174, dependent from one of independent claims 102 and 147, or claims dependent therefrom, are patentable at least due to their dependency from an allowable independent claim. Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered

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by the Examiner, placing claims 102-130, and 132-135, 137-140, 144-168, and 172-174 in condition for allowance.

In view of the foregoing remarks, Applicant submits that the claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment; the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-3726.

Respectfully submitted,

MARTIN &amp; FERRARO, LLP

Dated: August 13, 2008By: 

Amedeo F. Ferraro

Registration No. 37,129

1557 Lake O'Pines Street, NE  
Hartville, Ohio 44632  
Telephone: (310) 286-9800  
Facsimile: (310) 286-2795